

"Claim 1 broadens the search from a specific compound to any compound that inhibits testosterone, not only would this require an additional search, but it would constitute new matter give the lack of support in the spec for this broadening."

The Claim 1 mentioned in the aforesaid quotation is now Claim 15 in the present application.

Claims 1 to 14 are the claims that were active (and are still active) in the earlier prosecution of this patent application.

In the Interview Summary in connection with the interview held June 16, 2000, the Examiner stated: "To better place the claims in condition for allowance", (emphasis added) the Examiner suggested:

"1. In Claim 1, deleting the phrase ". . . and it's complications including but not limited to . . . , 2. In Claim 2, deleting the terms 'any substance which inhibits the release for effects of LHRH' and substitute therefore those agents for which there is support in the specification, chiefly flutamide, bicalutamide, and nilutamide on pp. 3-4 other specification, and 3. in all occurrences, deleting the terms ' . . . any other method with the intent of accomplishing systematic absorption of the drug sufficient to reduce atherosclerosis."

Applicants in the in the original prosecution followed the foregoing Examiner's instructions. On March 2, 2001 Applicant submitted an Amendment which included Claims 1, 2, 7, 10, and 13 in the amended form. In other words, in the Amendment filed March 2, 2001 Applicants did precisely what the Examiner wanted. Therefore, Applicants are now confused since the Advisory Action of December 20, 2001 held that Claim 1 broadens the search from a specific compound to any compound and inhibits

testosterone and this would not only require an additional search but would also constitute new matter given the lack of support in the spec for the broadening.

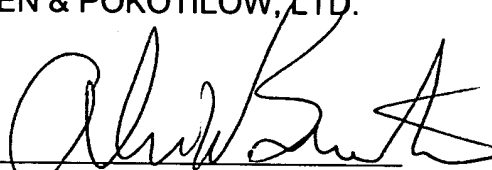
If the Examiner wishes, Applicants will cancel Claims 15 to 29 so that Claims 1 to 14 can be allowed. The Examiner is authorized to do so.

Respectfully submitted

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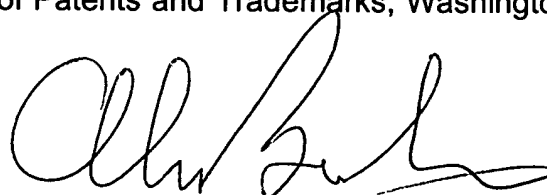
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CERTIFICATE OF MAILING

I hereby certify that the foregoing AMENDMENT ACCOMPANYING THE FILING OF REQUEST FOR CONTINUED EXAMINATION, re 09/089,583, is being deposited with the United States Postal Service, in duplicate, as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, this 25th day of February 2002.


Alan H. Bernstein